

REMARKS

The drawings, specification and claims have been amended to correct drafting errors as originally filed. No new matter has been added. Favorable consideration is respectfully requested.

The Examiner has merely copied claims 1, 3, 14, 15 and 19 word for word without comment or any indication of how the recitations can be read upon Lee. It appears that the Examiner is reading the element "drive member" upon both ratchet wheel 14 and connector 20 of Lee. It is respectfully submitted that a person skilled in the art would not construe the term "drive member" to include connector 20 of Lee, especially in the context of the drawings and specification. However, in a spirit of conciliation to advance prosecution of the present application, claims 1 and 20 have been amended to further define the drive member in a manner to distinguish over Lee and to prevent including connector 20 of Lee as the drive member. Thus, it is respectfully submitted that the rejections of the claims have been overcome. Favorable reconsideration is respectfully requested.

It should be appreciated that the female bit retaining member 200 of Anderson corresponds to the connector 20 of Lee. As such, the teachings of Anderson would be utilized to replace the tool kits 100, 300 of Anderson for the connector 20, screwdriver 40, shank 42, and socket 46 of Lee. There is nothing in Anderson which would suggest that its teachings would have application to modify ratchet wheel 14 of Lee. Thus, the rejections based upon Anderson have been overcome for this separate and independent reason. Favorable reconsideration respectfully requested.

The Examiner relies upon the disclosure of Taiwan Utility Model Publication No. 526807 cited in the specification of the present application. To assist the Examiner in distinguishing the present invention thereover, a copy thereof together with a translation of the Abstract has been provided in an Information Disclosure Statement.

It should be noted that the present application described Taiwan Utility Model Publication No. 526807 as "RELATED ART", and there has been no admission it is prior art. In this regard, Taiwan Utility Model Publication No. 526807 was published on April 1, 2003 or in other words after the filing of the present application. It is assumed that there is no corresponding U.S. application filed or the Examiner would have relied thereon. In this regard, the right is reserved to file affidavits proving invention prior to the July 8, 2002 filing date of Taiwan Utility Model Publication No. 526807. Although such affidavits are not believed necessary as Taiwan Utility Model Publication No. 526807 is not believed to

be prior art, it is respectfully requested that Examiner Ton contact the undersigned if such affidavits are felt necessary by the Examiner.

Furthermore, even assuming that Taiwan Utility Model Publication No. 526807 is prior art, it should be immediately appreciated that Taiwan Utility Model Publication No. 526807 is similarly deficient as Lee and Anderson as it does not suggest the annular groove and retainer in the inner periphery of drive member as recited in claim 1 as originally filed. Additionally, it should be appreciated that the reasons provided by the Examiner to show that the alleged modifications to the prior art are based upon the hindsight knowledge of the present invention for the sole basis of attempting to meet the recitations of the claims. Specifically, the CAFC in *Environmental Designs, Ltd., v. Union Oil Co. of Cal.*, 218 U.S.P.Q. 865, 870 (1983) stated:

All the pieces of the present invention were known in the art,... That all elements of an invention may have been old (the normal situation), or some old and some new, or all new, is however, simply irrelevant. Virtually all inventions are combinations and virtually all are combinations of old elements. A court must consider what the prior art as a whole would have suggested to one skilled in the art. (Case citations.)

Further, the CAFC in *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (1984) stated:

The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification. (Case citations.)

Furthermore, the CAFC in *American Hoist & Derrick Co., v. Sowa & Sons, Inc.*, 220 U.S.P.Q. 763, 771 (1984) quoted:

A patentable invention *** may result even if the inventor has in effect, merely combined features, old in the art, for their known purpose, without producing anything beyond the results inherent in their use. (Emphasis theirs.)

Similarly, the Court of Appeals for the Federal Circuit in *In re Sernaker*, 702 F.2d 989, 217 U.S.P.Q. 1, 5 (1983) stated:

We may assume, for purposes of this decision, that all the prior art references in this case are sufficiently related to one another and to a related and common art, that the hypothetical person skilled in the art must be presumed to be familiar with all of them. That being so, the next questions are (a) whether a combination of the teachings of all or any of the references would have

suggested (expressly or by implication) the possibility of achieving further improvement by combining such teachings along the line of the invention in suit, and (b) whether the claimed invention achieved more than a combination which any or all of the prior art references suggested, expressly or by reasonable implication.

It is respectfully requested that the Examiner identify where the prior art provides any suggestion that their respective teachings are deficient, that further improvement was possible or desirable, or that their respective teachings have been application in any structure than disclosed. It is respectfully submitted that the Examiner is utilizing the hindsight knowledge of the present invention by selecting just the right components from each reference (while disregarding the other components and teachings thereof) and combining such selected components in just the right way to arrive at the present invention. Thus, it is respectfully submitted that the rejections have been overcome for this separate and independent reason. Favorable reconsideration is respectfully requested.

Furthermore, claim 8 has been amended to further define the present invention in a manner to distinguish over Lee. In particular, the annular groove has been amended to define over notches 24 of Lee, and the locations of the flange and annular groove have been amended to define over the positions of Lee. It is respectfully submitted that these differences result in smoother operation and increased strength and are not in any way suggested by the prior art. Thus, it is respectfully submitted that the rejection of claim 8 has been overcome for this separate and independent reason. Favorable reconsideration is respectfully requested.

The Examiner has cited the United States patents listed in NOTICE OF REFERENCES CITED as A-F, H, J and K-M of Page 1 of 2 and A-E of Page 2 of 2 and indicated consideration of the United States patents cited by applicant. By the lack of application of these references and others like them within the classes or subclasses searched, the Examiner apparently recognizes the clear patentability of the present invention over any of these references.

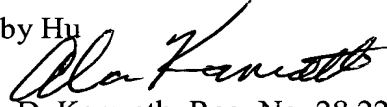
Therefore, since the claims of the present application have been shown to include limitations directed to the features of applicant's ratcheting wrench with quick tightening/loosening functions and fine adjusting function which are neither shown, described, taught, nor alluded to in any of the references cited by the Examiner and by the applicant, whether those references are taken singly or in any combination, the Examiner is

Serial No. 10/624,624

requested to allow claims 1-3, 5-12 and 14-21, as amended, of the present application and to pass this application to issue.

Respectfully submitted,

Bobby Hu



Dated: February 22, 2005.

Alan D. Kamrath, Reg. No. 28,227
NIKOLAI & MERSEREAU, P.A.
Attorneys for Applicant(s)
900 Second Avenue South
Suite 820 International Centre
Minneapolis, MN 55402
Tel: (612) 392-7306
Fax: (612) 349-6556